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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/810,475

03/26/2004

Michael W. Frauens

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9797

1333 7590 12/18/2007
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EXAMINER

LABOMBARD, RUTH NAOMI

ART UNIT

PAPER NUMBER

2852

MAIL DATE

DELIVERY MODE

12/18/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/810,475

Applicant(s)

FRAUENS ET AL.

Examiner

Ruth N. LaBombard

Art Unit

2852

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5, 7-12, 23-30 and 45-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 7-12, 23-30 and 45-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 October 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings comprising new figure 1A were received on 10/17/07. These drawings are acceptable.

Specification

2. The amendments to the specification received on 9/21/07 are acknowledged. The amendments are acceptable; however, the indicated location of insertion of the amended paragraphs, on page 2 of the communication received from the Applicants on 9/21/07, is not appropriate. It is suggested that the appropriate placement for the rewritten paragraph, "FIG. 1a is a schematic view of the developer system for applying the powder coating onto a substrate;" is page 7, not page 8, as indicated by the Applicants, and further that the amended paragraph should be inserted **after** the paragraph beginning on line 4 of page 7 since figure 1 still exists in the application. Additionally, the appropriate placement of the remaining amended paragraphs appears to be page 9, not page 10, as indicated by the Applicants. Further, the statement "This application is also referred to as SN 11/075,784" of the amendment is incorrect and should be deleted. Finally, the last sentence of the amendment should indicate Figure 1a and not Figure 1.

Claim Objections

3. Claims 1, 5, 8, 11, 23 and 45 are objected to because of the following informalities:

- a. Claims 1, 5, 8, 11, 23 and 45: "the magnetic brush" lacks antecedent basis.
- b. Claims 1, 5, 8, 11, 23 and 45: "the previous image" lacks antecedent basis and it is unclear what a 'previous image' constitutes.
- c. Claims 1, 5, 8, 11, 23 and 45: a print medium and substrate are disclosed and it is unclear whether the substrate and the print medium are the same.
- d. Claims 1, 5 and 8: claims 5 and 8 depend from claim 1 and yet contain the same amended limitation. Said amendment uses the alternative statement "one of a receiver and a substrate as well as the previous image." The use of multiples alternatives renders the claims unclear.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

- 4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
- 5. Claims 1-3, 5, 7, 10-12, 23 and 50 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Desie et al. (US 6,246,424 B1) in view of Kaukeinen et al. (JP 07043978 A) as presented in the Office action mailed on 6/21/07. Claims 1, 5, 11 and 23 have been amended to include the limitation "while the magnetic brush is in contact with one of a receiver and a substrate as well as the previous image." Both Desie et al. and Kaukeinen et al. disclose developing sleeves that are not in contact with the surface to be developed; however, it is clear that a magnetic brush contacts the surface to be developed in order to apply toner.

6. Claims 1, 8 and 9 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Costrop et al. (US 5,848,339) in view of Kaukeinen et al. (JP 07043978 A) as presented in the Office action mailed on 6/21/07. Claims 1 and 8 have been amended to include the limitation "while the magnetic brush is in contact with one of a receiver and a substrate as well as the previous image." Kaukeinen et al. disclose developing sleeves that are not in contact with the surface to be developed; however, it is clear that a magnetic brush contacts the surface to be developed in order to apply toner.

7. Claims 23-27 and 30 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Rushing (US 6,671,052 B1) in view of Kaukeinen et al. (JP 07043978 A) as presented in the Office action mailed on 6/21/07. Claim 23 has been amended to include the limitation "while the magnetic brush is in contact with one of a receiver and a substrate as well as the previous image." Kaukeinen et al. disclose developing sleeves that are not in contact with the surface to be developed; however, it is clear that a magnetic brush contacts the surface to be developed in order to apply toner.

8. Claims 23, 28, 29 and 45-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakazato et al. (US 6,483,997 B1) in view of Kaukeinen et al. (JP 07043978 A) as presented in the Office action mailed on 6/21/07. Claims 23 and 45 have been amended to include the limitation "while the magnetic brush is in contact with one of a receiver and a substrate as well as the previous image." Kaukeinen et al.

disclose developing sleeves that are not in contact with the surface to be developed; however, it is clear that a magnetic brush contacts the surface to be developed in order to apply toner.

Response to Arguments

9. Applicant's arguments filed 9/21/07 have been fully considered but they are not persuasive.

10. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

11. Applicants argue "Kaukeinen teaches away from the present invention, since in Kaukeinen, in order to develop a high-density image free from sac ravaging, the development must be done only when the developer is not in contact with the previous image." Kaukeinen is merely a secondary reference used for teaching a rotating magnetic core; however, the disclosed rotating magnetic core forms a magnetic brush of toner to develop and image. Such a development operation can not be completed without the developer contacting the surface to be developed. Further, it is unclear as to what 'previous image' the Applicants are referring.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth N. LaBombard whose telephone number is (571)

Application/Control Number:
10/810,475
Art Unit: 2852

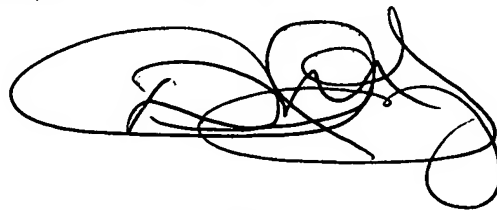
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272-6430. The examiner can normally be reached on Monday - Friday, 7:30am - 4:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Gray can be reached on (571) 272-2119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/RNL/
12/14/07

A handwritten signature in black ink, consisting of several overlapping loops and a long horizontal stroke at the bottom.

DAVID M. GRAY
SUPERVISORY PATENT EXAMINER